Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BURTON M. BAUM,
STEVEN E. LENTSCH,
and THOMAS R. OAKES

Appeal No. 1997-2671
Application 08/446,473

ON BRIEF

Before GARRIS, PAK, and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1 through 12 which are all of the claims pending in the application.

The subject matter on appeal relates to a method of sanitizing and destaining ware products comprising the step of applying to the ware a peroxyacetic acid concentrate composition having a particular formulation. Further details of this appealed subject matter are readily apparent from a review of illustrative independent claim 1 which reads as follows:

1. A method of sanitizing and destaining ware products comprising the step of applying to the ware a peroxyacetic acid concentrate composition comprising peroxyacetic acid, acetic acid, hydrogen peroxide and a carrier, wherein an initial mole ratio of acetic acid to hydrogen peroxide is less than 3:1; a mole ratio of acetic acid to peroxyacetic acid at equilibrium is less than 5:1, and wherein the composition is diluted upon application to a concentration of at least 30 ppm of peroxyacetic acid.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Fraula et al. (Fraula)	Re. 30,537	Mar. 3, 1981
Lokkesmoe et al. (Lokkesmoe)	5,122,538	Jun. 16, 1992

All of the appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Lokkesmoe in view of Fraula.[1]

[1]The appealed claims will stand or fall together; see page 4 of the brief. It follows that in our disposition of this appeal we will focus upon appealed claim 1 which is the sole independent claim before us.

OPINION

This rejection will be sustained.

Lokkesmoe discloses a point-of-use process for making a peroxyacetic acid concentrate composition of the type here claimed (e.g., see the paragraph bridging columns 2 and 3 and lines 54 through 64 in column 3) and a method of sanitizing and destaining ware products wherein the aforementioned concentrate composition is diluted to a concentration range of about 5-200 ppm (e.g., see lines 41 through 68 in column 6) as required by appealed claim 1. It is the appellants' basic position that this claim distinguishes over Lokkesmoe because the latter contains no teaching or suggestion of the here claimed mole ratios. We cannot agree.

In Example 3, Lokkesmoe discloses reacting a 1.5:1 mole ratio of acetic acid to hydrogen peroxide (e.g., see lines 56 and 57 in column 8). From our perspective, this disclosure teaches or at least would have suggested the appealed claim 1 requirement of an initial mole ratio of acetic acid to hydrogen peroxide of less than 3:1.

As for the here claimed 5:1 mole ratio of acetic acid to peroxyacetic acid at equilibrium, it is important to note that

patentee's concentrate composition includes a peroxy acid weight percentage range of 2% to 20% (e.g., see lines 6 through 11 in column 6) which is encompassed by the appellants' preferred 0.5-25 weight percent in concentrate of peroxy acid at equilibrium (see the table on specification page 20) and which substantially overlaps the appellants' preferred 5-12 weight percent in concentrate of peroxyacetic acid at equilibrium (see the table on specification page 22). This correspondence between the peroxy acid concentrations envisioned by the appellants and by Lokkesmoe coupled with the correspondence between the acetic acid to hydrogen peroxide mole ratios claimed by the appellants and disclosed by patentee support a reasonable conclusion that Lokkesmoe's composition would include an acetic acid to peroxyacetic acid mole ratio at equilibrium within the range required by appealed independent claim 1. Stating this last mentioned point differently, while the Lokkesmoe reference contains no express disclosure concerning the mole ratio of acetic acid to peroxyacetic acid at equilibrium for his composition, it is reasonable to consider patentee's composition as possessing

such a mole ratio within the here claimed range for the reasons discussed above.

In essence, the compositions disclosed by Lokkesmoe for use in his method appear to be identical to compositions encompassed by the here claimed method, and thus it is appropriate to require the appellants to prove that patentee's compositions do not necessarily or inherently possess the characteristics of their claimed composition including the appealed claim 1 mole ratio of acetic acid to peroxyacetic acid at equilibrium. Whether the rejection is based on "inherency" under 35 U.S.C. 102, on "prima facie obviousness" under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977).

In addition to the foregoing, we agree with the examiner's conclusion that it would have been obvious for an artisan with ordinary skill to determine workable or even optimum ranges for the mole ratio parameters discussed above. This is because such parameters are quite plainly result

effective variables as evinced by the Lokkesmoe patent. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) and In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (cited by the examiner on page 6 of the answer). Further, it is appropriate to regard the mole ratios of Lokkesmoe's composition, when so optimized, as falling within the here claimed ranges in light of the common sanitizing uses envisioned by patentee and the appellants for their respective compositions.

Under the circumstances recounted above, we consider the reference evidence adduced by the examiner to establish a prima facie case at least of obviousness within the meaning of 35 U.S.C. § 103.

According to the appellants, they "have provided in the working examples of their specification evidence of patentability of its selected use of a peroxy acetic acid concentrate over a known marketed peroxy acetic acid product" (brief, page 8). However, this evidence involves a comparison of the appellants' inventive composition to a marketed product known as OXONIA which is said by the appellants to be described in U.S. Patent No. 4,051,058. It is well settled

that an applicant relying upon a comparative showing to rebut a prima facie case must compare his claimed invention with the closest prior art. In re Merchant, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978). As explained above, the Lokkesmoe composition is virtually indistinguishable from the composition defined by appealed independent claim 1 and therefore is quite plainly the closest prior art. It follows that the appellants' specification evidence which relates to some other prior art composition has little if any probative value with respect to the issues raised by the rejection before us.

As a consequence, we will sustain the examiner's section 103 rejection of the claims on appeal as being unpatentable over Lokkesmoe in view of Fraula.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris Administrative Patent Judge	)	
Chung K. Pak Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Peter F. Kratz Administrative Patent Judge	)	

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MERCHANT, GOULD, SMITH,
EDELL, WELTER & SCHMIDT, P.A.
3100 Norwest Center
90 South Seventh Street
Minneapolis, MN 55402-4131